

**Request for Reconsideration:**

Applicant respectfully requests that the Examiner reconsider the above-captioned patent application in view of the following remarks.

**Remarks:**

1. Rejections

Claims 1-5 stand rejected under 35 U.S.C. § 103(a), as allegedly rendered obvious by Patent No. US 6,481,976 B2 to Kimura et al. (“Kimura”) in view of U.S. Patent No. 5,332,365 to Taguchi (“Taguchi ‘365”). Applicants respectfully disagrees.

2. 35 U.S.C. § 103(a)

Claims 1-5 stand rejected as allegedly rendered obvious by Kimura in view of Taguchi. In order for the Office Action to establish a prima facie case of obviousness, at least three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to those of ordinary skill in the art, to modify the primary reference as proposed by the Office Action. Second, there must be a reasonable expectation of success. Third, the prior art references must disclose or suggest all the claim limitations. MPEP 2143. For the reasons set forth below, Applicant respectfully submits that the Office Action fails to establish a prima facie case of obviousness.

Applicants’ independent claim 1 recites, in part: “a partition wall disposed around said valve element, . . . [and] a pressure chamber which partitioned from said valve chamber by said partition wall. . . whereby a gap is defined between said partition wall and said valve element for forming a non-contact structure.”

The Office Action asserts that Kimura discloses each and every limitation of independent claim 1, except that the pressure chamber is partitioned from the valve chamber by the partition wall. Nevertheless, the Office Action asserts that Taguchi discloses this missing limitation, and that it would have been obvious at the time of the invention to modify Kimura in

view of Taguchi to achieve Applicant's claimed invention. Specifically, the Office Action assert that Kimura discloses a partition wall 59 which does not contact a valve element 43. The Office Action also asserts that Taguchi discloses that a pressure chamber is partitioned from a valve chamber by a fixed partition wall 482.

The Office Action acknowledges that partition wall 482 contacts a valve element 481. Nevertheless, the Office Action asserts that if Kimura were modified to include partition wall 482 of Taguchi, it would have been obvious to have partition wall 482 not contact valve element 43 because partition wall 59 does not contact valve element 43, and it would not be necessary for partition wall 482 support valve element 43 because other elements already support valve element 43. Applicant respectfully disagrees.

Applicant respectfully submits that the Office Action fails to provide an apparent reason as to why one of ordinary skill in the art at the time of the invention would have been motivated to modify Kimura to include partition wall 482 of Taguchi if partition wall 482 would not support (contact) valve element 43 of Kimura in such a modification. For example, partition wall 59 of Kimura already includes passage 58 formed therethrough. The mere fact that a reference can be modified in of itself is insufficient to establish a prima facie case of obviousness, and the Office Action must establish why one of ordinary skill in the art would have been motivated to make the proposed modification. See, e.g., MPEP 2143.01 (III). In the above-captioned patent application, the Office Action merely asserts that Kimura could be modified to include partition wall 482 of Taguchi and to have partition wall 482 not contact valve element 43 of Kimura, however, the Office Action does not provide a reason as to why one of ordinary skill in the art would be motivated to make such a modification. Therefore,

Applicant respectfully requests that the Examiner withdraw the obviousness rejection of independent claim 1 at least for this reason.

Claims 2-5 depend from allowable, independent claim 1. Therefore, Applicant respectfully requests that the Examiner also withdraw the obviousness rejection of claims 2-5 at least for this reason.

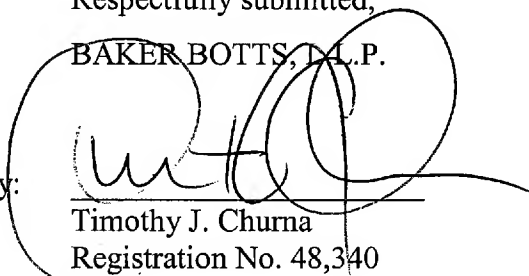
**Conclusion:**

Applicant respectfully submits that the above-captioned patent application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that the prosecution of this application may be furthered by discussing the application, in person or by telephone, with Applicant's representative, Applicant would welcome the opportunity to do so. Applicant believes that no fees are due as a result of this submission. Nevertheless, in the event of any variance between the fees determined by Applicant and the fees determined by the PTO, please charge or credit any such variance to the undersigned's **Deposit Account No. 02-0375**.

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Respectfully submitted,  
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